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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/352,192	07/12/99	HILL	J DYN-6D1-1
			EXAMINER

MM42/0128

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LEE, M	ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 01/28/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 1/11/2000 (Amend)
- ☒ This action is FINAL.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-6 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-6 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

Part III DETAILED ACTION

Prelim. Amdt./Amendment

1. Receipt is acknowledged of the Amendment filed 11 January 2000.

Specification

2. The disclosure is objected to because of the following informalities:

Page 8, line 35: Please provide "U.S. Patent Application Serial No. _____".

Page 10, lines 17-18: Please provide "U.S. Patent Application Serial No. _____".

Page 13, line 25: Please provide "U.S. Patent Application Serial No. _____".

Page 14, lines 14-15: Please provide "U.S. Patent Application Serial No. _____".

Page 19, lines 13-14: Please provide "U.S. Patent Application Serial No. _____".

Page 20, lines 16-17: Please provide "U.S. Patent Application Serial No. _____".

Page 21, line 18: Please provide "U.S. Patent Application Serial No. _____".

Appropriate correction is required.

Double Patenting

3. Claims 1-3 drawn to the system, and method claims 4-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 12-13 of U.S. Patent No. 5,494,544 (assigned to Mr. Jeffrey L. Hill et al, hereinafter '544).

Although the conflicting claims are not identical, they are not patentably distinct from each other

1 because in claims 1-6 of the instant application, Applicants claim a method of verifying and
2 validating the embossed information read from the embossed card to the prestored card
3 information prior to insertion of the embossed cards into the card carrying mailing forms, etc.

4 The method of performing the above claimed invention is recited in claims 1-3 and 12-13 of '544
5 patent. Although, the only difference between the present claimed invention and of the '544
6 patent is the utilization of different terminologies and/or rephrasing of the terminologies, etc., the
7 Examiner believes that the scope of claims 1-6 of the present application and claims 1-3 and 12-13
8 of '544 patent are almost identical but differ only in terminology and/or the way the terminologies
9 have been rephrased. Moreover, the Examiner believes that the instant claim is obviously
10 encompassed by the patented claims of '544 patent.

11 Thus, with respect to above discussions, it would have been obvious to an artisan of
12 ordinary skill in the art at the time the invention was made to utilized the teachings of claims 1-3
13 and 12-13 of '544 patent to modify the method of performing the packaging of the embossed
14 cards to perform the same functions, and to utilized the same terminologies as claimed by the
15 present application. To the extent that the instant claims are broaden and therefore generic to the
16 claimed invention of '544 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states
17 that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been
18 previously been claimed in a co-pending application.

19 The obviousness-type double patenting rejection is a judicially established doctrine based
20 upon public policy and is primarily intended to prevent prolongation of the patent term by

1 prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re*
2 *Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37
3 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the
4 conflicting application or patent is shown to be commonly owned with this application. See 37
5 C.F.R. § 1.78(d).

6
7 ***Claim Rejections - 35 USC § 102***

8 4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
9 basis for the rejections under this section made in this Office action:

10 A person shall be entitled to a patent unless --

11 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or
12 on sale in this country, more than one year prior to the date of application for patent in the United States.

13 5. Claims 1-3 drawn to the system, and method claims 4-6 are rejected under 35
14 U.S.C. 102(b) as being anticipated by Hill et al (US 4,034,210).

15 Hill et al teaches a system and method for processing a plurality of credit card carriers 1
16 comprising a bar code reader/optical reader [95, 159] (see col. 17, lines 19+; and col. 20, lines
17 50+) for reading from the carrier the carrier information 24b printed thereon (e.g., a plurality of
18 different standard codes/any type of bar codes (see col. 10, lines 43+; and col. 12, lines 16+), such
19 as, I-bar code, OCR, mag code, delta distance code, etc.); logic and command module (LCM) 97
20 (see col. 17, lines 27+) (i.e., means for comparing) for comparing the carrier information read
21 from the carrier with the stored carrier information to determine if there is a match with respect to

1 the embossed plastic card(s); means responsive to the comparing means for automatically
2 identifying each carrier for which the carrier information printed on the carrier does not match the
3 stored carrier information for the carrier with respect to the embossed plastic card(s); and the
4 LCM includes the means for automatically rejecting identified non-matching carriers to prevent
5 insertion of the embossed plastic cards into non-matching carriers. See also figures 1-4; col. 10,
6 lines 40+; col. 12, lines 9-60; col. 13, line 35 through col. 14, line 51; and col. 17, lines 27+.

7
8 ***Response to Arguments***

9 6. Applicant's arguments with respect to claim 1-3 have been considered but are moot in
10 view of the new ground(s) of rejection.

11 On page 1 of the Amendment: The changes to claims 36-38 were not entered because
12 claims 36-38 does not exist in this instant application. Please clarify in next communication.

13 In response to the Applicants remarks that "... ***even if the rejection were not improper***
14 ***because the patent office has already forced the applicant to file this divisional by previously***
15 ***asserting that the claims are distinct and is therefore estopped from now claiming that the***
16 ***claims are not distinct, ...***" (See page 3 of Remarks), the examiner respectfully requests the
17 applicants to provide any supporting document(s) with respect to the above quotation in the next
18 communication.

1 In response to the Applicants argument with respect to the rejection of claims 1-3 under
2 35 USC 102(b) (see page 3 of Remarks), the examiner respectfully requests the applicants to
3 further review paragraph five (5) above.
4

5 ***Conclusion***

6 7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office
7 action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is
8 reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

9 A shortened statutory period for reply to this final action is set to expire THREE
10 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
11 MONTHS of the mailing date of this final action and the advisory action is not mailed until after
12 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
13 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
14 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
15 however, will the statutory period for reply expire later than SIX MONTHS from the date of this
16 final action.

17 8. Any inquiry concerning this communication or earlier communications from the examiner
18 should be directed to **Michael G. Lee** whose telephone number is (703) 305-3503. The examiner
19 can normally be reached between the hours of 6:30AM to 4:00PM Monday thru Thursday and
20 every other Friday (first Friday of the bi-week).


1 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,
2 Donald T. Hajec, can be reached on (703) 308-4075. The fax phone number for this Group is
3 (703)308-5841 or (703) 308-7722.

4 Communications via Internet e-mail regarding this application, other than those under 35
5 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
6 addressed to [michael.lee@uspto.gov].

7 *All Internet e-mail communications will be made of record in the application file. PTO*
8 *employees do not engage in Internet communications where there exists a possibility that*
9 *sensitive information could be identified or exchanged unless the record includes a properly*
10 *signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly*
11 *set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and*
12 *Trademark on February 25, 1997 at 1195 OG 89.*

13 Any inquiry of a general nature or relating to the status of this application or proceeding
14 should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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MICHAEL G. LEE
Primary Examiner

Technology Center 2800
JANUARY 27, 2000